

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF PENNSYLVANIA

INDECK KEYSTONE ENERGY LLC,	:	
	:	
Plaintiff/	:	
Counter-defendant,	:	
	:	Civil Action No. 04-325 Erie
v.	:	
	:	Judge Sean J. McLaughlin
VICTORY ENERGY OPERATIONS	:	
LLC,	:	
	:	
Defendant/	:	
Counter-plaintiff.	:	

**MOTION FOR PRE-TRIAL FINDING THAT
IKE MUST ESTABLISH “WILLFUL INFRINGEMENT” UPON ITS
MARK IN ORDER TO RECOVER DAMAGES FOR TRADEMARK DILUTION**

Defendant Victory Energy Operations LLC (“VEO”), by its undersigned counsel, for its Motion For Pre-Trial Finding that IKE Must Establish “Willful Infringement” Upon Its Mark In Order to Recover Damages For Trademark Dilution, states as follows:

1. As Counts II and III of its Complaint, IKE has alleged claims of Trademark Dilution under the Federal Lanham Act (15 U.S.C. § 1125) and the Pennsylvania Trademark Act (54 Pa.C.S.A. § 1124), respectfully.

2. While both the Lanham Act and the Pennsylvania Trademark Act permit courts to award injunctive relief to protect the dilution of a famous mark, neither act authorizes an award of money damages absent a showing of willful infringement.

3. The Lanham Act specifically provides:

In an action [for trademark dilution], the owner of the famous mark shall be entitled **only to injunctive relief** as set forth in section 1116 of this title unless the person against whom the injunction is sought **willfully intended to trade on the owner’s reputation or to cause dilution of the famous mark**. If such willful intent is proven, the owner of the famous mark shall also be entitled to the

remedies set forth in sections 1117 (a) and 1118 of this title, subject to the discretion of the court and the principles of equity.

15 U.S.C. § 1125 (c)(2) (emphasis added).

4. The Pennsylvania Trademark Act includes nearly identical language to make clear that an injunction is the sole remedy available for a trademark dilution claim in the absence of a showing of willful infringement. Specifically, the Pennsylvania Trademark Act provides:

In an action [for trademark dilution], the owner of a famous mark shall be entitled **only to injunctive relief** in this Commonwealth, unless the person against whom the injunctive relief is sought **willfully intended to trade on the owner's reputation or to cause dilution of the famous mark**. If such willful intent is proven, the owner shall also be entitled to the remedies set forth in this chapter, subject to the discretion of the court and the principles of equity.

54 Pa.C.S. § 1124 (emphasis added).

5. Therefore, even if IKE is able to prove that VEO diluted the Keystone mark, it is only entitled to injunctive relief unless it also able to prove the VEO willfully intended to trade on IKE's reputation or to cause dilution of the Keystone mark.

WHEREFORE, Defendant Victory Energy Operations, requests that this Court enter a pre-trial order finding that IKE Must Establish "Willful Infringement" Upon Its Mark In Order to Recover Damages For Trademark Dilution.

Dated: April 20, 2007

Respectfully submitted,

/s/ Christopher T. Sheean
One of the Attorneys for Defendant,
VICTORY ENERGY OPERATIONS, LLC

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CERTIFICATE OF SERVICE

Christopher T. Sheean, an attorney, certifies that on the 20th day of April, 2007, he caused a copy of the foregoing ***Defendant's Motion For Pre-Trial Finding that IKE Must Establish "Willful Infringement" Upon Its Mark In Order to Recover Damages For Trademark Dilution*** to be filed electronically, and that the CM/ECF system for the court will e-mail a copy of the foregoing to the following counsel of record:

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/s/ Christopher T. Sheean
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